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RECORD OF ORAL HEARING

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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*Ex Parte* TETSURO MOTOYAMA, AVERY FONG and
YEVGENIYA LYAPUSTINA

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Appeal 2009-008304
Application 10/684,434
Technology Center 2100

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Oral Hearing Held: February 4, 2010

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*Before* LEE E. BARRETT, JAY P. LUCAS and
THU A. DANG, *Administrative Patent Judges*

ON BEHALF OF THE APPELLANT:

SURINDER SACHAR, ESQ.
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THE USHER: Calendar Number 32, Mr. Sachar.

MR. SACHAR: Okay. Thank you.

THE USHER: You're welcome.

JUDGE LUCAS: Good afternoon. Mr. Sachar?

MR. SACHAR: Yes.

JUDGE LUCAS: At one point will you please give your card to the court reporter? We have two visitors today. They are both examiners, neither of whom are involved with your case, but they were just observing: Mr. Matthew Campbell and Mr. Christopher Crutchfield.

JUDGE BARRETT: Okay. And whenever you're ready.

MR. SACHAR: Thank you, Your Honors. The claims at issue in this case are directed to operations of monitoring what, for example, buttons a user selects at an image forming apparatus. We are all familiar with a copy machine or a printer having a user interface and operation panel, and the user will select various buttons operations on that panel. This invention is directed to monitoring what operations the user selects on that operation panel, making a log of those selections and then communicating it.

The reason this would be useful is if you are a designer of the operation panel, it can be useful to know what buttons operations a user selects, the order that they select them in, the frequency that they select them, et cetera. Our position is that first, neither of the references to why Wygodny or Aikens are directed to that type of feature. The references are similar, and they're directed to monitoring how software is executed within a device, the different programs, the different functions, the different call operations that the software will execute as it's operating.

Wygodny is the primary reference disclosing something that they refer to as a bug tracer, which will essentially monitor how a software is being executed so that you can later review that and discover bugs in the software. Our position is that at no point does Wygodny disclose monitoring the actual selections picked by a user on an operation panel, nor would Wygodny make a log of those selections.

Aikens is actually somewhat similar, and Aikens discloses monitoring how a software again is being -- Aikens will generate a log of different operations -- during execution of a software program for the purpose of if a crash occurs in the software, being able to go back and say what routines, et cetera, the software was executed that may have resulted in that crash. So in that respect Aikens is somewhat similar to Wygodny, but again, Aikens has the same deficiency with respect to the claims as written, as Aikens also does not monitor what operations a user selects on an operation panel and then make a log of those operations to later communicate.

JUDGE DANG: If I can interrupt, you said that Aikens does monitor the operations, but it doesn't monitor the selected operations?

MR. SACHAR: Aikens monitors the operation being executed by the software. In other words, a software program will start running and Aiken will monitor how that software is progressing.

JUDGE DANG: Okay.

MR. SACHAR: But that's different than monitoring what buttons, for example, a user presses on an operation panel. In other words if someone comes up and wants to execute a print operation, there's various programs, call functions that will be executed. Aiken will monitor, will take a

log of some of those.

JUDGE DANG: Okay. I understand that. Now, why don't we go to the claim language and then you can tell me how the monitoring of the buttons is indicated in the claims?

MR. SACHAR: Sure. For example, claim 1 recites "a monitoring unit configured to monitor data of," and I guess this is the important language, "selecting the plurality of operations of the operation panel by the user." So the image forming device includes an operation panel. We're selecting the plurality of operations. I'm sorry. We're monitoring the plurality of operations selected by the user, and that's what we believe is different than what's happening in Wygodny and Aikens.

JUDGE DANG: Oh, I'm sorry. Okay. The operation panel comprising operations to be selected by the user.

MR. SACHAR: Yes.

JUDGE DANG: And then you have monitoring data of selecting. So I guess you're saying that data of selecting is limited to monitoring of buttons?

MR. SACHAR: It's directed to get what data the operator selects, the user selects.

JUDGE LUCAS: That's an odd expression that caused us a bit of confusion in our discussions; "to monitor data of selecting the plurality of operations." How do you feel that it should be interpreted?

MR. SACHAR: That should be interpreted as the operation panel has different operations the user can select, and the data that's monitored is which operations the user is selecting. So monitoring data of

selecting of the operations by the user.

JUDGE DANG: Right. Okay. So on operation panels, right? Operation panels, in any operation panel, like even Aikens, the user does select "Hey, I want to staple. I want to sort." Those are operations that are selected by the user. What I'm trying to understand here is you're now claiming, I guess, your assertion is that monitoring data of selecting has to be the choice versus data relating to the selection, which is data relating to the operation that's selected.

MR. SACHAR: Yeah. In our device we're monitoring the selections by the user.

JUDGE DANG: Right. I understand that. I'm just looking at the claim language here. You say, "Monitor data of selecting."

MR. SACHAR: Again, "by the user." I guess I would interpret "by the user" is part of that same, directed to the same, interpretation. It's the selections by the user that we're monitoring.

JUDGE LUCAS: You didn't say though that you're monitoring the actual selections of the users. You expressed it broader: "monitoring data of selecting." So if they select something and it causes a bunch of other actions to occur, those other actions sound like they would be covered by the claim language.

MR. SACHAR: Our intent in the claim language is to cover what the user is selecting on the operation panel.

JUDGE BARRETT: So in the phrase, "selecting of the plurality of operations of the operation panel by the user" is a discrete unit data of that unit is what you're claiming.

MR. SACHAR: Yes. Yes, and I believe the Examiner has interpreted the claims the same way in applying the art. I don't think the Examiner -- I don't believe -- is taking the position that there's a different monitoring operation.

JUDGE BARRETT: If the user were to say 10 copies and they made a record of that, a log of it, would that satisfy the claim?

MR. SACHAR: What the claim would be directed to is the user pressing the buttons that say, "copy," 10, you know, "print," something to that effect.

JUDGE DANG: Right. And then the system in Aikens then monitors to see whether or not you need to replenish toner or whatever.

MR. SACHAR: Yes.

JUDGE DANG: So the number 10 that's been selected goes into the monitoring to see whether or not it hits the maximum number in order to replenish the toner of our paper.

MR. SACHAR: I believe the way Aiken would work, Aiken would monitor say the toner level, and if the toner level dropped below a certain level, it would indicate a command, or it would monitor the software that monitors the level. But Aiken would never keep a log that the user selected the buttons 10, "print," et cetera.

So Aikens or Wygodny, both, they're not monitoring what the selections are. They would monitor operations in the device on particularly the software operating device to see how that software was executed, but not actually monitoring what selections are made.

JUDGE DANG: Right. And I guess by those factors the claim

language that I'm trying to understand is that you say you don't monitor the selection. You said you monitored data of selecting; and so that's what I'm trying to understand here.

MR. SACHAR: Well, we do monitor the selection. That is what we monitor, the data of the selection, not the downstream operations that result from the selection.

JUDGE LUCAS: I think we see your intent. What's troubling a bit is the actual verbiage of the claim.

MR. SACHAR: And as I said, I don't think that was an issue with the Examiner's interpretation of it. I believe the Examiner understood that, and also had the similar understanding of the scope of the claim.

JUDGE DANG: So the Examiner is saying that the system of Aikens monitors events and he indicated -- I think he -- right, Examiner's indicated that the actual selection is an event. Isn't that what the Examiner was saying?

MR. SACHAR: Well, I thought it was a little different. I believe that what the Examiner was looking at, for example in Aikens to give some specifics. At column 4 Aikens actually says that an event could be something such as user interfaced buttons being set. I believe what that's directed to is the software in the machine.

JUDGE DANG: Right.

MR. SACHAR: And that's not we are directed to. We are not directed to how the software will process different operations. We are directed to again what the user is selecting on the operation panel.

JUDGE BARRETT: These are machine operating events as

opposed to user selection events?

MR. SACHAR: Yes, that's the distinction.

JUDGE BARRETT: Anymore questions?

JUDGE LUCAS: I think we understand his point of view.

JUDGE DANG: Anything else you'd like to add?

MR. SACHAR: No. I think that expresses our view.

JUDGE BARRETT: Thank you very much.

Whereupon, at 1:13 p.m., the proceedings were concluded.